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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,529	07/07/1999	ALAN SLATER	CITI0109-US	5359

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KING & SPALDING LLP (CITI CUSTOMER NUMBER)

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3696

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06/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/348,529	Applicant(s) SLATER ET AL.	
	Examiner DANIEL S. FELTEN	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The receipt of the applicant's amendment filed 03/24/2009 is acknowledged. Claims 50-113 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. ***Regarding Applicant's Response to Examiner's Non-Responsive Amendments:***

Upon further consideration of the applicant's Amendment and Response filed November 27, 2007 and Applicant's arguments, see page 14, filed 03/24/2009, the allegations of Non-Responsive Amendment filed February 11, 2008 and February 24, 2009 has been withdrawn.

Regarding Applicant's Response to the 35 USC § 101 Rejection:

The Examiner maintains the rejection. The Examiner agrees that the determination of whether each of the "whereby" clauses in a limitation in a claim depends on the specific facts of the case. For Example, in *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), that has been cited by the Applicant, the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.*

However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed.Cir. 2003)) that a "whereby clause in a method claim *is not* given weight when it simply expresses *the intended result of a process step positively recited.*" *Id.* In this case, as in at least claim 55, the claim reads,

Art Unit: 3696

"...processing a transaction at the second location with the scanned image of the deposited check, **whereby** pickup of the check received at the first location **can be** delayed **or** eliminated, **resulting** at least in cost savings **or** improvements in payment settlement times by processing the transaction with the scanned image at the second location."

It is respectfully being maintained that what is being expressed in the underlined is an *intended result* of processing of the transaction and thus is not given patentable weight [see MPEP 2111.03]. Moreover, further rejections under 35 USC § 101 are being maintained below and are provided below.

Regarding the Applicant's Response to the 35 USC 112, second paragraph Rejection

3. The 35 USC 112 is being maintained. the word "can" given its plain definition has several connotations, one of which is *to have the possibility: A coin can land on either side.*(See definition 6, Dictionary.com). It is being submitted that under at least one of the plain definitions of "can" it is maintained that it is unclear as to whether the limitation is positively recited. However, it is acknowledged that the applicant is entitled to be his or her own lexicographer [MPEP 2111.01]. Thus the applicant is invited to provide an explicit definition for the term "can" which will control the interpretation of the term as it is used in the claim [see *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)] (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so

Art Unit: 3696

understood by a person of experience in the field of the invention.” *MultiForm Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP § 2173.05(a).

Regarding Applicant's Response to the 35 USC § 103 Claim Rejections

4. Applicant's arguments filed 03/24/2009 have been fully considered but they are not persuasive. In response to applicant's arguments against the references, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is also respectfully submitted that references, in determining obviousness are not read in isolation but for what they fairly teach in combination with prior art as a whole, thus the patent assignee's reference-by-reference attack on the art to demonstrate non-obviousness is not persuasive [see *Photo electric sensing system-Banner Engineering v. Tri-Tronics Co. Inc.*, 29 USPQ 1392 1389 (CAFC 1993 unpub) citing *Inre Merck*, 231, USPQ 375 (CAFC 1986)]. In this case, the primary reference- Gustin discloses both a method and system for image based transactions (see Gustin, Abstract). The images are received by at least scanning the front and back face of the negotiable instrument to create an electronic validation of the deposited instrument (see Gustin, Figure 13, column 4, lines 3-8 for *depositing of cash into the machine and transferring money by wire*; also column 18, lines 3-7; and column 13, lines 5+, *where the scanner 60 scans both sides*). The Applicant continues to assert that Gustin fails to teach or suggest (i) transmitting the electronic validation of deposited

Art Unit: 3696

cash from the first location to a second location and processing a transaction at the second location with the electronic validation of deposited cash, as recited in independent claims 50 and 53. The Examiner disagrees. Gustin discloses that the wire transfer is communicated through a modem (electronically) of the machine to the banking network and thence to the recipient's account in the receiving bank (see column 4, line 47-51). It is being submitted that is notoriously old and well known in the wire transfer art that a validation code (IBAN or BIC) is sent from the sending bank to the receiving bank with a message that may include settlement instructions (e.g., SWIFT or FEDWIRE are old systems that do this). Thus, the Examiner maintains that Gustin's wire transfer communication of at least a IBAN or BIC through a modem to the recipient's account implies an electronic validation being transferred from one location (sender's/user's bank) to a second location. It is also submitted that Gustin may further read on this limitation in sending payments for bills (see Gustin column 5, lines 2-13) where transactions may be tagged.

The applicant asserts that Gustin fails to disclose (ii) transmitting an image of the scanned deposited check from the first location to a second location and processing a transaction at the second location with the scanned image of the deposited check, as recited in independent claims 55 and 77. The Examiner disagrees and encourages the applicant re-read citations related to figs. 14, 16A and 18B,

(iii) transmitting an image of the scanned deposited check from the first location to a second location and processing a transaction at the second location with the scanned image of the deposited check without verification of the signature of the user initiating the transaction, which

Art Unit: 3696

signature is used to verify that the user is a profiled user within a specified system, as recited in (iv) handling the check received at the first location by delaying pickup of the check or eliminating pickup of the check

Claim Rejections - 35 USC §101

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 50-76, 92-96 and 102-113 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

7. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

8. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

Art Unit: 3696

9. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, since scanning can be interpreted as being done by human eyes and transmitting and be performed manually. Thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 50-76, 92-96 and 102-113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement [see MPEP 2172.01]. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. what structure is being used to perform receiving, scanning, transmitting and processing

[see In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c)]

Art Unit: 3696

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 50-76, 92-96 and 102-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claims 50-96, 102-104 and 108-110 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a scanner, device used for receiving, device used for transmitting, processing etc.,

[See *In re Venezia* 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965)]

Art Unit: 3696

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 50-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustin and Wensink. See rationale provided above in the Response to Arguments as well as Office action mailed 7/27/2007 regarding how Gustin does not explicitly show paper cash, but uses cash equivalents like money orders which may be converted to legal tender and where Wensink provides a scanner that can be equally substituted for Gustin's scanner to provide documents of legal tender (or cash) (see Wensink, column 6, lines 50-64) and how it would be obvious for an artisan at the time of Gustin's scanner to scan paper cash so as to provide a means of monitoring and tracking. Such a modification would provide added convenience to the customer and security during future transactions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL S. FELTEN whose telephone number is (571)272-6742. The examiner can normally be reached on Flex.

Art Unit: 3696

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel S Felten
Primary Examiner
Art Unit 3696

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